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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,768	02/08/2005	Johann Robert	1200.725	2672

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Liniak Berenato
Longacre & White
Suite 240
6550 Rock Spring Drive
Bethesda, MD 20817

EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

MAIL DATE	DELIVERY MODE
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10/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,768

Applicant(s)

JOHANN ROBERT

Examiner

Vinh T. Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/8/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Attachment.

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1. The preliminary amendment filed on February 8, 2005 has been entered.
2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because of the implied phrase "[t]he present invention. Correction is required. See MPEP § 608.01(b).
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, the notch in Claim 2 (see paragraph [0037] of the specification), the projecting or recessed reliefs in Claim 4 (paragraph [0039]), the fixed support in Claim 5 (paragraph [0031]), the spiral with continuous turns in Claim 7 (paragraph [0027]), and the opening leaf of the motor vehicle and the side door of the vehicle in Claim 8 (paragraph [0023]) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

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be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The use of the trademark, such as, "ZAMAK" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

6. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.

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(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(g) BRIEF SUMMARY OF THE INVENTION.

(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(i) DETAILED DESCRIPTION OF THE INVENTION.

(j) CLAIM OR CLAIMS (commencing on a separate sheet).

(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

7. The disclosure is objected to because of the informalities, *inter alia*, listed below:

(a) The disclosure should have appropriate headings, listed above; and

(b) Each part of the invention, such as, the notch in Claim 2, the projecting or recessed reliefs in Claim 4, the fixed support in Claim 5, the spiral with continuous turns in Claim 7, and the opening leaf of the motor vehicle and the side door of the vehicle in Claim 8 should be indicated by a reference character.

Appropriate correction is required.

8. Claims 5 and 6 are objected to because of the following informalities: no antecedent basis is seen for the term "it" in Claim 5. Appropriate correction is required.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 2-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant recites, *inter alia*, the notch in Claim 2, the projecting or recessed reliefs in Claim 4, the fixed support in Claim 5, the spiral with continuous turns in Claim 7, and the opening leaf of the motor vehicle and the side door of the vehicle in Claim 8. However, the drawings do not show the instant elements. It is unclear as to how Applicant makes or uses the instant elements and how the instant elements are inter-structurally connected to other claimed elements.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example, the term "this orifice" in Claim 1 should have been changed to - - said orifice - -.

The recitation "a module (10) forming a lock mechanism, of the *type* comprising a Bowden-*type* cable" in Claim 1 is indefinite because it was unclear what "*type*" was intended to convey. See *Ex parte Copenhaver*, 109 USPQ 118 (Bd. App. 1955) and MPEP 2173.05(b).

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim

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does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, *e.g.*, Claim 7 recites the broad recitation "at least one wire," and the claim also recites "particularly a metal wire, wound into a spiral with continuous turns," which is the narrower statement of the range/limitation.

The term "intended to be" in Claim 9 is vague and indefinite in the sense that things which may be done are not required to be done. For example, the jacket is intended to be *but is not structurally required to be* immobilized by two proximal and distal retaining elements. *Cf.*, "discardable" in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), "crimpable" in *Application of Collier*, 158 USPQ 266 (CCPA 1968), "removable" in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and "comparable" in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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14. Claims 1, 2, 4-7, and 9, as best understood, are rejected under 35 U.S.C. 102(b) as anticipated by Gutschner (US Patent No. 6,178,845 cited by Applicant).

Regarding Claim 1, Gutschner teaches a control device for a module 12 forming a lock mechanism, of the type comprising a Bowden-type cable containing a cable 3 having two ends, a proximal end (see Attachment hereinafter "Att.") and a distal end (Att.) respectively, this cable 3 being housed in a jacket 2 having two ends, a proximal end 14 and a distal end (Att.) respectively, which are immobilized by two proximal and distal retaining elements 13 and 5, characterized in that *at least* one of the ends of the jacket 2 is connected to the corresponding retaining element 13 by adhesive bonding (*i.e.*, gluing. *Ibid.* col. 2, lines 61-64), the bonded retaining element 13 being provided with a part 16 forming a sleeve 16 for fitting the bonded end 4 of the jacket 2, the sleeve-forming part 16 containing an orifice (FIG. 4 of Att.) which is substantially transverse to the direction in which the bonded end 4 of the jacket 2 is fitted, this orifice (FIG. 4 of Att.) forming a receptacle (FIGS. 4 and 6) *for* holding a mass of adhesive in contact with the jacket 2 and the bonded retaining element 13.

Claim 1 and other claims below are anticipated by Gutschner because Gutschner teaches each and every positively claimed element in the claims. Referring the control device to merely inferentially included element or intended use element, such as, the mass of adhesive is not accorded patentable weight. It is well settled that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then, it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition,

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note that the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997). In the instant case, Gutschner's receptacle is capable of holding the mass of adhesive in the same manner as Applicant's receptacle.

Regarding Claim 2, the bonded end 4 of the jacket 2 is its proximal end.

Regarding Claim 4, the edges of the orifice (FIGS. 4 and 6) are provided with projecting or recessed reliefs 33.

Regarding Claim 5, the sleeve-forming part 16 of the bonded retaining element 13 is extended by a shell 20, 27 provided with (groove) means 21 for securing it to a fixed support 12 as seen in FIG. 5. *Ibid.* col. 2, line 65 through col. 3, line 18.

Regarding Claim 6, the proximal end (FIG. 2 of Att.) of the cable 3 is provided with a block 18 for securing this cable 3, the shell 20, 27 forming a housing for this securing block 18.

Regarding Claim 7, the jacket 2 is formed by at least one wire.

Regarding Claim 9, Gutschner teaches a method of adjusting a Bowden-type cable containing a cable 3 having two ends, a proximal end (FIG. 2 of Att.) and a distal end (Att.) respectively, this cable 3 being housed in a jacket 2 having two ends, a proximal end 4 (Att.) and a distal end (Att.) respectively, this jacket 2 being *intended to be* immobilized by two proximal 13 and distal 5 retaining elements, characterized in that: the length of the proximal end (Att.) of the cable 3 protruding outside the jacket 2 through the proximal end 4 of the latter is adjusted, then the proximal end 4 of the jacket 2 is fastened to the proximal retaining element 13 by adhesive bonding. *Ibid.* col. 2, lines 51-64 and Claims 1-4.

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15. Claims 3 and 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Crepin (adhesive, see col. 3, lines 36-45), Ernst (adhesive, see abstract), Courtot (adhesive, col. 2, lines 11-16), Roeser (epoxy receptacle C in FIG. 1), and Bauer et al. (FIG. 2).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Luong

October 10, 2007



Vinh T. Luong
Primary Examiner

ATTACHMENT

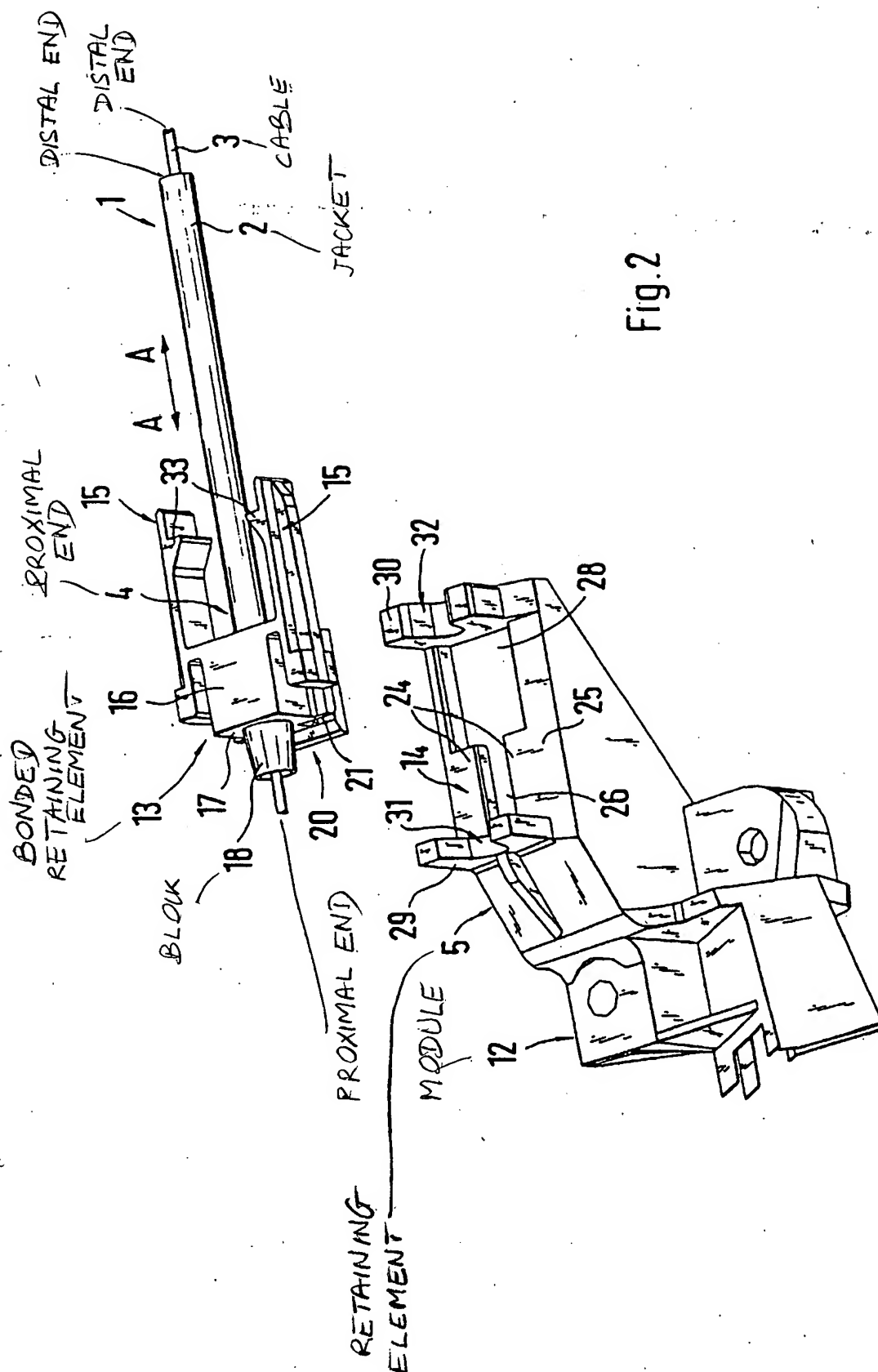


Fig. 2

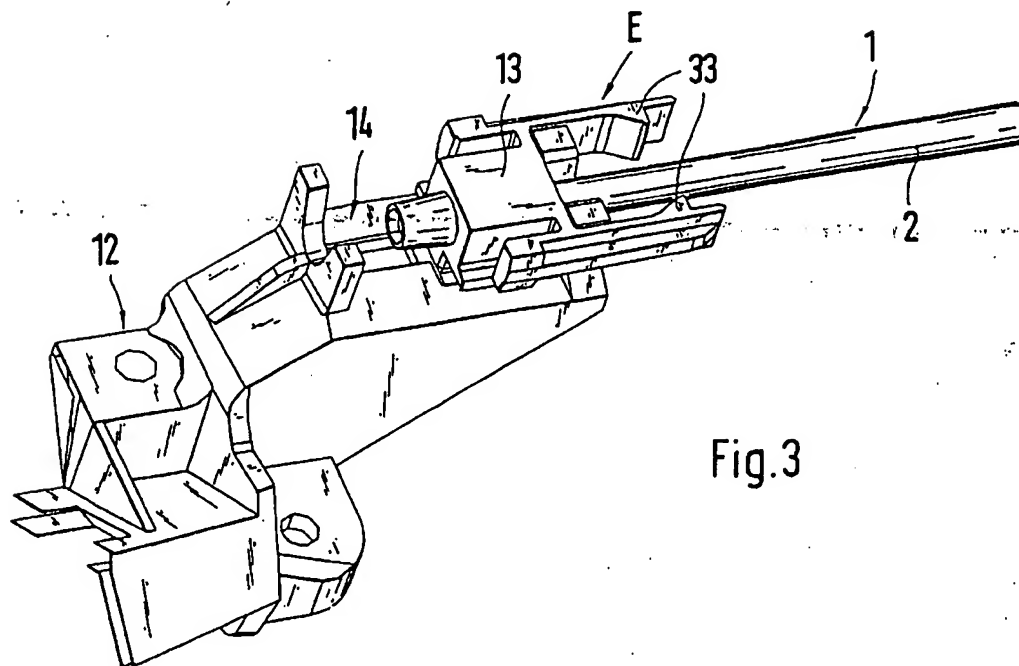


Fig.3

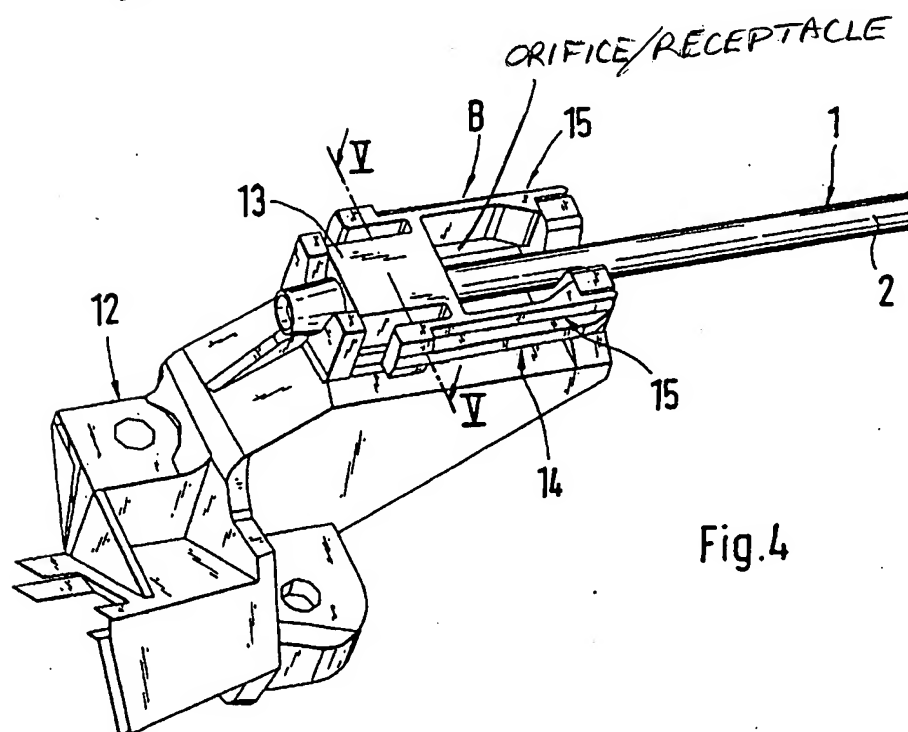


Fig.4

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